REMARKS

The Examiner has rejected claims 1, 21 and 22 under 35 U.S.C. §112, Second Paragraphs. The Examiner has rejected claims 21 and 22 under 35 U.S.C. §101. For prior art rejections, the Examiner has rejected independent claims 1 through 22 under 35 U.S.C. §103 on the previous rejection bases.

In view of the above claim amendment and the following remarks, the Applicant respectfully requests the Examiner to reconsider the pending rejections.

The Section 112 Rejections

The Examiner has maintained the rejection of claims 1, 12 21 and 22 under 35 U.S.C. §112, Second Paragraph. In response to these claim rejections, the Examiner is kindly asked to consider the following arguments.

The Examiner has kindly pointed out in Paragraph 14 that "new address" has been recited in multiple times in claim 1. The Examiner has stated that "a new address" and "the new address" are vague due to the multiple occurrence of the claim term. Accordingly, independent claims 1, 21 and 22 have been amended to clarify the subject matter limitations with respect to the claim terms. Newly amended independent claims 1, 21 and 22 now explicitly recite "a new address" only once, and the subsequent recitation of the "new address" is strictly referring to the same occurrence of the initial "new address" based upon proper antecedent basis.

In addition, the Examiner has also pointed out another rejection basis for independent claims 1, 21 and 22 under 35 U.S.C. §112, Second Paragraph. The Examiner has alleged that the subject matter is vague and indefinite in "requesting an

address definition from a second device to a first device" and then "returning the address definition containing a plurality of components to the second device from the first device." The Examiner commented that one does not "see how the address definition can be returned from the first device when the first device is requesting the address definition from the second device."

In response to the above second source of alleged indefiniteness, the Applicant respectfully points out to the Examiner that independent claim 1 explicitly recites "requesting an address definition from a second device to a first device." Although the Examiner understood the above recitation to mean that the first device is requesting the address definition from the second device, it is the second device that is making the request for an address definition since the request is made from the second device. One of ordinary would understand the above ordinary meaning of the claim language in view of the specification at line 31 on page 7 through line 4 on page 8. The similar understanding should be realized with respect to other independent claims. For the above described reasons, the Applicant respectfully submits to the Examiner that the currently recited claim language is not indefinite or vague.

Based upon the above claim amendments and the remarks, the Applicant believes that newly amended independent claims 1, 12 21 and 22 now particularly point out and distinctly claim which the Applicant regards as the invention. Thus, the Applicant respectfully submit to the Examiner to withdraw the rejections of claims 1, 12 21 and 22 under 35 U.S.C. §112, Second Paragraph.

The Section 101 Rejections

The Examiner has rejected claims 21 and 22 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In Paragraph 7 of the Office Action, the Examiner has kindly suggested the claim amendment including "a computer readable

storage medium to overcome the pending rejections under 35 U.S.C. §101. Accordingly, the independent claims have been amended to incorporated the suggested subject matter limitations.

In Paragraph 17 of the pending Office Action, the Examiner appears to maintain a second rejection basis under 35 U.S.C. §101. In response to this rejection basis, the Applicant respectfully points out that Figure 1 of the current application discloses a "memory unit." It appears irrelevant whether or not the specification discloses as to what kind of a computer readable medium.

In Paragraph 18 of the pending Office Action, the Examiner appears to maintain third rejection basis under 35 U.S.C. §101. For satisfying the practical application requirement to bring about a useful, concrete and tangible result, the Applicant respectfully request the Examiner to consider the step of "returning the newly generated address definition including the new address" in the rejected claims. The newly generated address definition is a useful, concrete and tangible result that is "maintained in a flexible and independent manner" as the new address generation is "optionally performed in combination with a predetermined set of rules on the addresses that are stored in an independent address maintenance unit." (*see* all in Abstract).

Based upon the above reasons, the Applicant respectfully submit to the Examiner to withdraw the rejections of claims 21 and 22 under 35 U.S.C. §101.

The Section 103 Rejections

The Examiner has rejected claims 1, 2, 12 and 22 under 35 U.S.C. §103 as being unpatentable over Holleran et al. in view of Taylor et al. The Examiner has also rejected claims 3, 4, 10 and 11 under 35 U.S.C. §103 as being unpatentable over Holleran et al.

and Taylor et al. and further in view of Krishnaswamy et al. The Examiner has rejected claims 5 through 9 under 35 U.S.C. §103 as being unpatentable over Holleran et al., Taylor et al. and Krishnaswamy et al. further in view of Ouchi. Lastly, the Examiner has indicated the rejection bases of claims 13 through 21 correspond to those of claims 1 through 12 and 22.

In response to the Applicant's argument submitted on July 2, 2008, the Examiner has provided Response to Arguments in Paragraph 9 of the pending Office Action dated August 19, 2008. The Examiner has characterized in Paragraph 9 that the Applicant's argument is relied upon the Taylor's lacking disclosure for automatically generating new mail address. This characterization of the Applicant's argument is not correct.

As already provided in the previous response, the Applicant had argued that the two cited portions of the Taylor reference are not disclosing what the Examiner has characterized. That is, line 52, column 23 through line 18, column 24 of the Taylor reference fails to teach, disclose or suggest "a new address definition based upon the corresponding conditions at the second device" as explicitly recited by independent claim 1. By the same token, lines 19 through 40, column 24 of the Taylor reference fails to teach, disclose or suggest "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions" as explicitly recited by independent claim 1. The Applicant respectfully request the Examiner to review the following arguments in view of the above two patentable distinctions.

For rejecting independent claims 1, 12, 21 and 22, the Examiner has combined Holleran et al. and Taylor et. Al. In this regard, the Holleran et al. reference discloses an apparatus for depicting an electronic mail address in either a filed format or a string format.

As described with respect to pairs of Figures 6B and 6C, Figures 8 and 9, Figures 11a and 11b as well as Figures 12a and 12b, the same address is shown either in the filed format or the string format. The string format shows the address information in an unformatted way. On the other hand, the field format shows the same address in a predetermined formatted way. For example, Figure 11a illustrates the format style by displaying "Pat Holleran" and "3rd Floor" in the two predetermined units of information as name and zone. On the other hand, Figure 11b illustrates the string style by displaying "PatHolleran@3rd Floor," which is generated from the same information without any conditional limitation.

The Examiner has conceded in Paragraph 21 of the currently pending Office Action that the Holleran et al. reference "fails to teach generating a new address definition based upon the corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions." For the lack of the necessary disclosure, the Examiner has cited the Taylor et al. reference.

In general, the Taylor et al. reference discloses an integrated system for electronic mail, facsimile transmission, terminal emulation and file synchronization among distributed computers. An electronic address book allows information to be efficiently sent to users of both electronic mail and facsimile transmission. To optimize the communication, five types of address cards are implemented to include a person card, a group card, a computer card, a calling card and a service card. For example, the person type address cards hold personal and destination information about a specific person or entity. Similarly, the group type address cards hold group/personal and destination information about a specific person or group. The personal/group and destination information further include a list of "electronic mail addresses" as well as phone and fax numbers. The only existing mail addresses are stored, and no new mail addresses are "automatically" generated.

In his characterization of the second prior art reference, the Examiner has asserted that the Taylor et al. teaches both of the lacking disclosures in the Holleran et al. reference. For the lacking disclosure, "a new address definition based upon the corresponding conditions at the second device," the Examiner has alleged that the Taylor et al teach the same subject matter at line 52, column 23 through line 18, column 24. Similarly, for the lacking disclosure, "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions," the Examiner has alleged that the Taylor et al teach the same subject matter at lines 19 through 40, column 24.

The Taylor et al. reference at line 52, column 23 through line 18, column 24 discloses how to "assemble pieces of the message, which collectively form the envelop, and create a package which conform to the format requirements of the communication service to which the package is intended" with respect to FIGURE 16. (lines 6 through 9, column 24). In regard to address, the Service type address card contains the user identification, the password and the telephone access number for an electronic mail. (line 66, column 23 through line 4, column 24). In contrary to the Examiner's characterization, the Applicant respectfully submit that the first alleged portion of the Taylor et al. reference thus fails to teach, disclose or suggest "a new address definition based upon the corresponding conditions at the second device."

By the same token, the Taylor et al. reference at lines 19 through 40, column 24 discloses methods including "GetAddressTemplate" and "MakePckage." In particular, the "GetAddressTemplate" method only confirms the address format for the service provider. (lines 19 through 22, column 24). The "MakePckage" method receives (i) an array of items to be included in the package, (ii) a list of recipients, (iii) description, (iv) a message, (v) a list of attachment files and (vi) a time stamp. (lines 23 through 29, column 24). The "MakePckage" method prepares a communication package including the above

in a format that is acceptable to a destination communication service. (lines 29 through 31, column 24). The rest of the cited portion discloses "DestroyData," "GetNote," "GetDistList" and "GetAttachments" methods for reversing the above packaging processes for obtaining a specified piece of information from a package. (lines 32 through 40, column 24). Thus, in contrary to the Examiner's characterization, the Applicant respectfully submit that the second alleged portion of the Taylor et al. reference again fails to teach, disclose or suggest "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions."

For the rejections of dependent claims, the Examiner has cited two additional prior art references in further combination of the above discussed prior art references. Namely, the Krishnaswamy et al. reference generally discloses systems and methods of routing and managing telephone calls, data and other multimedia information including audio and video through a switched network such as a Public Switched Telephone Network (PSTN) which includes transfer of information across the Internet. In managing the above system, a user profile information is stored, and the user information includes name, address, fax number, IP address and e-mail address as disclosed in column 27.

Furthermore, the Krishnaswamy et al. reference discloses "X. INTERNET TELEPHONY AND RELATED SERVICES" in columns 74 through 113. The communication in the Internet telephony includes connections between 1) PC to PC, 2) PC to PSTN, 3) PSTN to PC and 4) PSTN to PSTN. To manage these communication transactions, the user profile method is created based upon the information that is gathered from individual users as disclosed in column 108. The information includes name, address, e-mail address and IP addresses that have been already generated before and stored elsewhere. The user must input the above information.

The Ouchi reference generally discloses a message-based workflow systems and methods for computer networks. By use of the e-mail based system, the Ouchi reference exemplifies a workflow of submitting, approving and reimbursing business expenses for predetermined projects. For each project, a predetermined set of e-mail addresses is assigned to perform the above exemplary tasks. For example, the approval task is performed by a predetermined singular manager or one of pre-assigned managers depending upon the employee who submits the request. In any case, the e-mail addresses are stored in advance for various employees, tasks and projects, and the predetermined rules or conditions simply determine to retrieve one of the previously stored e-mail addresses. In other words, the retrieved address is not "automatically" generated, but simply retrieved.

For the above reasons, even if the four cited references are combined in any manner, no teaching, disclosure or suggestion is provide based upon the combined cited references for the generation of a new address that is different from an existing one.

Dependent claims 2 through 11 ultimately depend from independent claim 1 and incorporate the patentable feature. Dependent claims 13 through 20 ultimately depend from independent claim 12 and incorporate the same patentable feature of independent claim 12. Thus, it would not have been obvious to one of ordinary skill in the art to provide the patentable feature of the independent claims based upon the four cited references alone or in combination. Therefore, the Applicant respectfully submits the Examiner to withdraw the rejections of claims under section 103.

Conclusion

      In view of the above remarks and attachments, the Applicants respectfully submits that all of the pending claims are in condition for allowance and respectfully request a favorable Office Action so indicating.

Respectfully submitted,

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